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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,320	01/11/2002	Fumio Sugaya	Q66578	4444

7590 06/30/2005

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Washington, DC 20037-3202

EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,320

Applicant(s)

SUGAYA ET AL

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6-6-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 6, 2005 has been entered.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,496,518 to Arai et al.

Arai et al teach an incubator. The incubator comprises a cell/chamber (64) for a dry chemical analysis element (1). The cell/chamber (64) is heated with heaters (48, 57) and maintains a constant temperature within the cell/chamber (64). The incubator

further comprises a pressing member (61) disposed within cell/chamber (64). See figure 5. The pressing member (61) presses downward onto analysis element (1) and fixes the analysis element (1) in a position within the cell (64), as recited in claim 7. The downward action of the pressing member (61) is caused by a spring (62), as recited in claim 2. See col. 7, lines 7-22. Within cell/chamber (64), a guide member (64b) is disposed. The guide member (64b) guides the pressing member (61) upward and downward (col. 7, lines 33-36). Heater (57) is provided on the outer surface of cell cover (46). Heater (57) allows cell (64), guide member (64b) and pressing member (61) to be held at a predetermined temperature (col. 11, lines 35-40), as recited in claim 4. Regarding claim 5, Arai et al teach a cell cover (46) having the heater (57), which is in contact with the guide (64). With respect to claim 3, Arai et al teach that the pressing member (61) may be integral with the cell member (64). The reference further teaches that cell member (64) can be easily removed from the incubator for cleaning or replacement (col. 11, lines 59-61; col. 12, lines 14-16). Thus, pressing member (61) is inherently capable of being removed also.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 102(b) in view of the teachings of Arai et al.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3, 6-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al '518 in view of US Patent 4,814,279 to Sugaya.

The disclosure of Arai et al is described above. Arai et al differ from the instantly claimed invention in that there is no disclosure of 1) the pressing member defining a top surface of the chemical analysis chamber, 2) the pressing member having a tapered surface, or 3) the pressing member contacting a substantial area of the analysis element.

Sugaya teaches an incubator (6) comprising a pressing member (20) having a tapered outer edge (19). See col. 4, lines 31-41. The pressing member presses onto slide/analysis element (1) to hold slide (1) in place. The pressing member (20) also contacts a substantial portion of slide (1), forming the top portion of slide chamber. It would have been obvious to one of ordinary skill in the art to modify Arai et al by using a tapered outer edge to allow the slide to move into the incubator more easily. Further, it would have been obvious to provide a flat pressing member that defines a portion of the analysis chamber to seal the opening where sample liquid has been spotted onto the slide and repair any curling of the slide that may have resulted from pushing the slide into the incubator.

With respect to the guide member being an inclined member, both Arai et al and Sugaya teach the guide member as a flat member. However, it would have been obvious to one of ordinary skill in the art to incline the guide member such that it would provide better contact for the guide against the pressing member for heating. Such would allow no heat to be lost from lack of contact.

### *Response to Arguments*

6. Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive.

Applicants note in their response that the features now recited in claim 1 are sufficient to overcome the Arai et al reference. The Examiner does not agree that reciting the function of the heater (how the heater operates) is sufficient to overcome the teachings of Arai et al. The Examiner notes that in claims directed to an apparatus, the manner in which the device operates does not differentiate an apparatus claim from the prior art. Applicants must distinguish the claims in terms of structure, rather than function. See MPEP 2114. Thus, Applicants' recitation of the heater "heating the guide member to a predetermined temperature by directing heat produced by the heater directly onto a surface of the guide member" does not structurally define the claimed heater over the heater disclosed by Arai et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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